

Docket No: PFLUG
Ser. No: 09/754,618

REMARKS

This Amendment is submitted preliminary to the issuance of an Office Action in the present application, for which applicant has requested a continued examination (RCE) following a decision by the Board of Patent Appeals and Interferences (BPAI).

Applicant submits that the RCE is filed timely, that is, within the time limit given to applicant/appellant for filing an appeal with the Court of Appeals for the Federal Circuit (CAFC) or the commencement of a civil action pursuant to MPEP 706.07(h) XI A.

Applicant has amended claims 1 and 7 to point out with more specificity that the material used for the disks in the scroll compressor are from through-hardened material having a martensitic structure throughout the entire cross section. Support for the amended claims can be found in paragraph [0008] of the description.

Applicant submits this amendment for the Examiner's consideration following the BPAI decision on December 30, 2004. The Board has pointed out repeatedly (also during oral argument) a distinction between 'through-hardenable' ferrous material and 'through-hardened' ferrous material. The Board appears to imply that the prior art as it is currently applied is based on the expression "through-hardenable" as compared to "through-hardened" (opinion, footnote 3 and oral argument). Claims 1 and 7 as amended therefore refer to

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"through-hardened ferrous material that has an even martensitic structure throughout the entire cross section".

None of the presently applied prior art when combined as per the Examiner show the use of through-hardened ferrous material providing an even martensitic structure through the cross section of the disks of a scroll compressor for a thrust ball bearing.

It is applicant's contention that in view of the Board's decision, the prior art as applied by the Examiner in the original claims are not applicable to the claims as amended and pending an updated search to make a final determination about patentability of independent claims 1 and 7, the claims would be allowable.

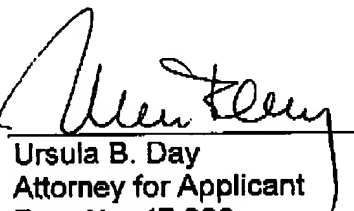
In view of the above, each of the presently pending claims in this application is considered patentably differentiated over the prior art of record and believed to be in conditions for allowance. Reconsideration and allowance of the present application are thus respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

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The Commissioner is hereby authorized to charge any fees which may be required during the pendency of this application, including any patent application processing fees under 37 C.F.R. 1.17, and any filing fees under 37 C.F.R. 1.16, including presentation of extra claims, or credit any overpayment to Deposit Account No: 06-0502.

Respectfully submitted,

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